

REMARKS/ARGUMENTS

I. General Remarks and Status of the Claims.

Claims 1-26 remain pending in this application. Claims 27-66 have been cancelled herein in response to a telephone restriction requirement imposed by the Examiner. In a telephone conversation with the Examiner on October 18, 2005, Applicants provisionally elected Group I, claims 1-26 for prosecution on the merits. Applicants hereby confirm the provisional election. Moreover, Applicants reserve the right to present claims 27-66 in one or more continuing applications.

II. Remarks Regarding the Examiner's Statements Regarding Applicants' Use of the Trademark "SPHERELITE" in the Specification.

The Examiner has noted Applicants' use of the trademark SPHERELITE in paragraph [0024], and has stated that "no generic terminology or description of SPHERELITE has been provided." (Office Action at 3.) Applicants respectfully disagree, and respectfully submit that Applicants' statement in the specification that SPHERELITE particles are "hollow particles . . . which generally [are] obtained from the waste-stream of coal-burning processes," *see* Specification, at [0024], provides sufficient generic description of the SPHERELITE particles.

III. Remarks Regarding the Rejection of Claims 1-3, 9-17, and 21 Under 35 U.S.C. § 102.

Claims 1-3, 9-17, and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,530,402 issued to Smith, et al. (hereinafter "*Smith*"). With respect to claims 1-3, the Examiner has stated:

Smith et al discloses a process of cementing a well wherein a spacer fluid is injected into the well annulus in conjunction with the injection of a cementing slurry.

Insofar as Smith et al does not require or specify that the spacer fluid must be completely and totally displaced from the casing/formation annulus, it is deemed that at least a portion of the spacer fluid will inherently or necessarily remain in the annulus during the setting of the cement, depending especially on the length of the casing, and will thus become "trapped" within such annulus, e.g., due to at least some adherence to the borehole wall during circulation and/or upon the closing of one or more

circulation valves during the cement setting phase, as called for in claims 1-3.

(Office Action at 4-5.) Applicants respectfully traverse, and submit that *Smith* has not been shown to disclose or suggest every element recited in the subject claims as required to anticipate the claims under 35 U.S.C. § 102(b). MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004) (hereinafter “MPEP”). In particular, Applicants respectfully submit that *Smith* has not been shown to teach or suggest “permitting at least a portion of the well fluid to become trapped within the annulus” as recited by Applicants’ independent claim 1, and that the Examiner’s assertion that “at least a portion of [*Smith*’s] spacer fluid will inherently or necessarily remain in the annulus during the setting of the cement” lacks the requisite evidentiary support.

Smith appears to be directed to a method of completing a wellbore in which a spacer fluid comprising microspheres is introduced into a well bore, and then “a completion fluid, such as a cement slurry, is introduced to displace the spacer fluid out of the wellbore.” (*Smith*, 2:17-22). Applicants respectfully submit that this teaching by *Smith* that the spacer fluid comprising microspheres is displaced from the well bore by the completion fluid teaches away from Applicants’ claimed invention, which contemplates that a portion of a fluid comprising hollow spheres will remain within a well bore annulus. Because *Smith* has not been shown to teach, for example, that the low density spacer fluid is only partially or incompletely displaced from the annulus, Applicants respectfully submit that *Smith* has not been shown to teach “permitting at least a portion of the well fluid to become trapped within the annulus,” as required by Applicants’ independent claim 1.

The Examiner has not cited any portion of *Smith* as disclosing that a portion of *Smith*’s spacer fluid is permitted to become trapped within the annulus. However, the Examiner has asserted “that at least a portion of the spacer fluid will inherently or necessarily remain in the annulus during the setting of the cement, depending especially on the length of the casing, and will thus become ‘trapped’ within such annulus, e.g., due to at least some adherence to the borehole wall during circulation and/or upon the closing of one or more circulation valves during the cement setting phase,” *see* Office Action at 4-5. However, as the MPEP notes:

To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be

established by probabilities or possibilities. *The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*”

MPEP § 2112.IV. (emphasis added). Accordingly, the Examiner is required to provide extrinsic evidence to support a contention that a portion of *Smith*'s spacer fluid inherently would become trapped within the annulus. Applicants respectfully submit that the Examiner has not provided the requisite extrinsic evidence to support the Examiner's assertion. That the Examiner must provide such evidence is reiterated in Section 2144.03.B of the MPEP, stating that “the Board cannot simply reach conclusions based on its own understanding or experience--or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.” Accordingly, because the Examiner has not provided concrete evidence to disclose or suggest the limitation of “permitting at least a portion of the well fluid to become trapped within the annulus,” Applicants respectfully submit that independent claim 1 and the claims dependent therefrom, have not been shown to be anticipated by *Smith*. Accordingly, Applicants respectfully request the timely issuance of a Notice of Allowance for these claims.

IV. Remarks Regarding the Rejection of Claims 4, 5, 7, and 22 Under 35 U.S.C. § 103

Claims 4, 5, 7, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Smith* in view of U.S. Patent 5,783,822 to Buchanann, et al (hereinafter “*Buchanann*”). Applicants respectfully disagree. The Examiner has stated:

Buchanann et al (note, e.g., the Abstract) discloses a method of cementing a well wherein a tracer is included in the well cementing slurry.

(Office Action at 6.)

Claims 4, 5, 7, and 22 depend from, and include all the limitations of, independent claim 1. As Applicants have explained in Section III. above, the Examiner has not shown that *Smith* discloses all elements of Applicants' independent claim 1, particularly the element of “permitting at least a portion of the well fluid to become trapped within the annulus.” Nor has the Examiner shown or alleged that *Buchanann* supplies this missing element. Because dependent claims 4, 5, 7, and 22 include all the limitations of its corresponding independent

claim 1, the failure of *Smith* and *Buchanann* to teach or suggest all limitations of claim 1 prevents the combination from teaching or suggesting all limitations of claims 4, 5, 7, and 22. MPEP § 2142 (2004)(stating that a combination of prior art references must teach or suggest each element in a claim to form a basis for a § 103(a) rejection).

Therefore, dependent claims 4, 5, 7, and 22 are allowable for at least the reasons cited above. Accordingly, Applicants respectfully request withdrawal of the outstanding rejection with respect to dependent claims 4, 5, 7, and 22, and respectfully request the timely issuance of a Notice of Allowance for claims 4, 5, 7, and 22.

V. Remarks Regarding the Rejection of Claims 18-20 Under 35 U.S.C. § 103

Claims 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Smith* in view of U.S. Patent 6,722,434 to Reddy, et al (hereinafter "*Reddy*"). Applicants respectfully disagree. The Examiner has stated:

Reddy et al discloses the inclusion of a gas-generating additive in a well treating fluid which, in one embodiment may include a spacer fluid for use in a process of cementing a well (note col.2, lines 16-28).

(Office Action at 6.)

Claims 18-20 depend from, and include all the limitations of, independent claim 1. As Applicants have explained in Section III. above, the Examiner has not shown that *Smith* discloses all elements of Applicants' independent claim 1, particularly the element of "permitting at least a portion of the well fluid to become trapped within the annulus." Nor has the Examiner shown or alleged that *Reddy* supplies this missing element. Because dependent claims 18-20 include all the limitations of independent claim 1, the failure of *Smith* and *Reddy* to teach or suggest all limitations of claim 1 prevents the combination from teaching or suggesting all limitations of claims 18-20. MPEP § 2142 (2004)(stating that a combination of prior art references must teach or suggest each element in a claim to form a basis for a § 103(a) rejection).

Therefore, dependent claims 18-20 are allowable for at least the reasons cited above. Accordingly, Applicants respectfully request withdrawal of the outstanding rejection with respect to dependent claims 18-20, and respectfully request the timely issuance of a Notice of Allowance for these claims.

VI. Remarks Regarding the Rejection of Claims 23-26 Under 35 U.S.C. § 103

Claims 23-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Smith* in view of Applicants' alleged admission of prior art in paragraph [0027] of Applicants' Specification. Applicants respectfully disagree. The Examiner has stated:

It is observed that in Para [0027] of the specification, applicant indicates that other additives for spacer fluids, including the sodium metasilicate and acid pyrophosphate components in claims 23-26, are all "commercially available... under the tradenames "FLOW CHEK" and "SUPER FLUSH", as well as the tradename "MUD FLUSH".

(Office Action at 7.)

Claims 23-26 depend from, and include all the limitations of, independent claim 1. As Applicants have explained in Section III. above, the Examiner has not shown that *Smith* discloses all elements of Applicants' independent claim 1, particularly the element of "permitting at least a portion of the well fluid to become trapped within the annulus." Nor does Paragraph [0027] of Applicants' Specification constitute an admission by Applicants that the subject element was within the prior art. Accordingly, the Examiner has not shown that the combination of *Smith* and Paragraph [0027] of Applicants' Specification constitute prior art (or an admission of a prior art teaching) that teaches or suggests all limitations of claim 1, which prevents the combination from teaching or suggesting all limitations of claims 23-26. MPEP § 2142 (2004)(stating that a combination of prior art references must teach or suggest each element in a claim to form a basis for a § 103(a) rejection).

Therefore, dependent claims 23-26 are allowable for at least the reasons cited above. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to dependent claims 23-26, and respectfully request the timely issuance of a Notice of Allowance for these claims.

**SUMMARY AND PETITION FOR ONE-MONTH EXTENSION OF TIME
TO FILE THIS RESPONSE**

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding objections and rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants' Response to this Office Action was due on January 24, 2005. Accordingly, Applicants have included herein a Petition for One-Month Extension of Time to File this Response, along with check no. 956139 for the fee of \$120.00 under 37 C.F.R. 1.136(a). The Commissioner is hereby authorized to charge Baker Botts L.L.P. Deposit Account No. 02-0383 (Order Number 063718.0457) for any underpayment, or to credit same with any overpayment of fees, in association with this filing.

Applicants believe that there are no additional fees due in association with the filing of this Response. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, the Commissioner is authorized to debit Baker Botts L.L.P. Deposit Account No. 02-0383, Order No. 063718.0457, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,



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Date: February 21, 2006